

### **REMARKS**

Claims 1-11 and 13-23 are pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

### **DOUBLE PATENTING**

Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claims 1-10 of co-pending Application No. 11/099,254. Applicants now file a terminal disclaimer along with this Response. Therefore, Applicants respectfully request reconsideration and withdrawal of this double patenting rejection.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1, 7-17, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin et al. (U.S. Pat. No. 6,045,887) in view of Simons (U.S. Pat. No. 1,635,350).

Claims 2-6, 18-19, and 21-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin et al. in view of Simons and in further view of Pearce (U.S. Pat. No. 5,367,839).

These rejections are respectfully traversed.

Claims 1 recites, in part, a "body portion being provided with a first configuration adapted to be used with a first platen configuration and having first segments defining regions of weakened material, wherein said sheet material is adapted to be separated

along said first segments to change a configuration of said body portion of said sheet material to correspond with a second platen configuration having different external dimensions than said first configuration.”

Claim 17 recites, in part, a “body portion being provided with a first configuration adapted to be used with a first platen configuration and having first marking segments, wherein said sheet material is adapted to be separated along said first marking segments to change a configuration of said body portion of said sheet material to correspond with a second platen configuration having different external dimensions than said first configuration.”

Claims 1 and 17 are each directed to an abrasive sheet with a body that can be provided with a first configuration adapted to be used with a first platen configuration and a second configuration corresponding to a second platen configuration having different external dimensions than the first configuration. Thus, the bodies of the abrasive sheets of Claims 1 and 17 can be adapted to fit platens of different configurations and sizes.

The Office Action acknowledges that the Martin et al. reference fails to disclose or alone suggest each and every feature of Claims 1 and 17. In particular, the Office Action acknowledges that the Martin et al. reference fails to disclose the following features of Claims 1 and 17: “first segments defining regions of weakened material, wherein the sheet material is adapted to be separated along the first segments to change a configuration of the body portion of the sheet material to correspond with a second platen configuration having [a] different external dimension than the first configuration.” See September 30, 2005 Office Action at 5.

The Simons reference appears to disclose, with reference to Figures 1-3, a piece of sand paper 1 having divisional scores or lines 4. The lines 4 divide the sand paper 1 into four equally sized squares. The lines 4 are provided to allow the sand paper 1 to be torn along the lines 4 to modify the size of the sand paper 1 to be sufficient for the size of the article being sanded. See Col. 2, lines 48-50. The sand paper 1 can also be folded along the lines 4 into a pad 5 to facilitate transportation of the sand paper 1. See Col. 2, lines 54-66. The Simons reference fails to disclose or suggest a first configuration of the sand paper 1 for use with a first platen configuration and separating the sand paper along the lines 4 to provide the paper 1 with a second configuration corresponding to a second platen configuration having different external dimensions than the first platen configuration.

In particular, the Simons reference fails to disclose or suggest "wherein said sheet material is adapted to be separated along said first [marking (Claim 17)] segments to change a configuration of said body portion of said sheet material to correspond with a second platen configuration having different external dimensions than said first configuration," as set forth in Claims 1 and 17.

As set forth above, both the Martin et al. and Simons references fail to disclose or suggest each and every feature of Claims 1 and 17. Therefore, combination of the Martin et al. and the Simons references fails to render each and every feature of Claims 1 and 17 obvious.

The Office Action's rejection of Claims 1 and 17 is also traversed because the Office Action's assertion that combination of the Martin et al. and Simons references suggests the features of Claims 1 and 17, namely the feature of wherein said sheet

material is adapted to be separated along said first [marking] segments to change a configuration of said body portion of said sheet material to correspond with a second platen configuration having different external dimensions than said first configuration, lacks factual support in the record and is based on impermissible hindsight.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. *Ex parte David L. Robinson, et al.*, Appeal No. 2005-0111, March 18, 2005. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 U.S.P.Q. 173, 178 (C.C.P.A. 1967). Broad conclusory statements regarding the teachings of multiple references, standing alone, is not sufficient. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See *In re Mills*, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1990). Even if combination of the references teaches each and every element of the claimed invention, an obviousness rejection is improper without a motivation to combine the references. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998).

In this case, the Office Action fails to provide any evidence or explanation as to why and/or how one of ordinary skill in the art would have been motivated to modify the teachings of the Martin et al. reference in light of the Simons reference to arrive at a

sheet material having a first configuration for use with a first platen configuration and separating the sheet material along first [marking] segments to change a configuration of the sheet material to correspond with a second platen configuration having different external dimensions than the first configuration. The Office Action is using impermissible hindsight to combine the Martin et al. and the Simons references in an attempt to render the features of Claims 1 and 17 obvious.

For the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of the Section 103 rejection of Claims 1 and 17, and those claims dependent therefrom.

Claim 21 recites, in part, “wherein said body portion and tip portion have varying configurations defined by second and third segments defining regions of weakened material, wherein said sheet material is adapted to be separated along said second segments to separate a first tip portion, having a first tip configuration, from a first body portion having a first body configuration and said sheet material is adapted to be selectively separated along said third segments to separate a second tip portion, having a second tip configuration different from said first tip configuration, from a second body portion having a second body configuration different from said first body configuration.”

The outstanding Office Action acknowledges that the Martin et al. reference fails to disclose or alone suggest the above recited features of Claim 21 at page 7 of the Office Action.

The Simons reference appears to disclose, with reference to Figures 1-3, a square sheet of sand paper 1. The sand paper appears to include divisional or score lines 4 that separate the paper 1 into four equal square portions. The Simons reference

fails to disclose or suggest that the sand paper has a tip portion and second and third segments of weakened material, separation of the sheet along the second segment separates a first tip portion having a first tip configuration from a first body portion having a first body configuration and separation of the sheet along the third segment separates a second tip portion having a second tip configuration that is different from the first tip configuration.

The Pearce reference appears to disclose, with reference to Figure 1, a square abrasive sheet having separable circular areas 2 and 2'. The Pearce reference fails to disclose or alone suggest that the abrasive sheet includes a tip portion and second and third segments of weakened material, separation of the sheet along the second segment separates a first tip portion having a first tip configuration from a first body portion having a first body configuration and separation of the sheet along the third segment separates a second tip portion having a second tip configuration that is different from the first tip configuration.

As set forth above, the Martin et al., the Simons, and the Pearce references each fail to disclose or suggest each and every feature of Claim 21. Therefore, combination of the Martin et al, the Simons, and the Pearce references fails to render obvious each and every feature of Claim 21. In particular, combination of the cited references fails to render obvious "wherein said body portion and tip portion have varying configurations defined by second and third segments defining regions of weakened material, wherein said sheet material is adapted to be separated along said second segments to separate a first tip portion, having a first tip configuration, from a first body portion having a first body configuration and said sheet material is adapted to be selectively separated along

said third segments to separate a second tip portion, having a second tip configuration different from said first tip configuration, from a second body portion having a second body configuration different from said first body configuration,” as recited in Claim 21.

The Section 103 rejection of Claim 21 and those claims dependent therefrom is also improper because the rejection lacks factual basis and is based on impermissible hindsight. In particular, the Office Action fails to provide any evidence or explanation as to how one of ordinary skill in the art would have been motivated to modify the teachings of the Martin et al., the Pearce, and the Simons references to arrive at the invention of Claim 21 and those claims dependent therefrom.

Applicants respectfully request reconsideration and withdrawal of this Section 103 rejection of Claim 21 and those claims dependent therefrom.

### CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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